

Application No. 08/468,437
Amendment dated May 9, 2005
Reply to Office Action of November 9, 2004

REMARKS

Status Of Application

Claims 52-67 are pending in the application; the status of the claims is as follows:

Claims 64-67 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,034,804 to Sasaki et al. (“Sasaki”).

Claims 52-67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,067,029 to Takahashi (“Takahashi”) in view of Sasaki.

Claims 52-67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of U.S. Patent No. 4,887,161 to Watanabe et al. (“Watanabe”).

Claim Amendments

Claims 52-55 and 64 have been amended to more particularly point out and distinctly claim the subject matter of the invention. These changes do not introduce any new matter.

35 U.S.C. § 102(e) Rejection

The rejection of claims 64-67 under 35 U.S.C. § 102(e) as being anticipated by Sasaki, is respectfully traversed based on the following.

Claim 64 has been amended to recite, *inter alia*, a digital camera including a controller adapted to” determine a remaining capacity of a memory card after the first image is stored to the memory card and prior to capturing a second image; and display a warning prior to capturing the second image if the remaining capacity of the memory card is insufficient to store the second image.” That is, a remaining capacity of a memory card is detected after a first image is stored to the memory card, but before a second image is

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captured, and a warning is displayed if the remaining capacity of the memory card is insufficient to store another image. Support for this amendment is found, for example, in Fig. 16B and the corresponding description at page 45. In contrast, Sasaki teaches that an image is captured to a buffer memory, the amount of memory required by the image is determined (based on image size, compression parameters, etc.), and then the memory card is checked to determine if there is sufficient room to store the captured image. (“after the coding operation, data is temporarily stored in buffer memory 31₆. The memory capacity necessary for storing one frame data is determined according to the application condition of buffer memory 31₆, and therefore it is possible to calculate the number of data blocks to be used”). See column 8, line 60-65. Clearly, claim 64 distinguishes Sasaki.

Claims 65-67 depend from claim 52. However, the office action appears to address them as though they depend from claim 64. Regardless, it is respectfully submitted that claims 65-67 distinguish over Sasaki for at least the same reasons as set out below regarding claims 52-67.

Accordingly, it is respectfully requested that the rejection of claims 64-67 under 35 U.S.C. § 102(e) as being anticipated by Sasaki, be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejections

The rejection of claims 52-67 under 35 U.S.C. § 103(a), as being unpatentable over various combinations of Takahashi, Sasaki, and Watanabe, is respectfully traversed based on the following.

According to the Examiner, Takahashi modified by the teaching of Sasaki or Watanabe suggests that a warning is made when the capacity of a memory card is not sufficient to hold an image even if the memory card exists, since the memory card can be selected by the user even if the image information can be stored in an inside memory. (See the outstanding official action page 6, lines 15 to 20, page 10, lines 3 to 9, and page 13, lines 10 to 18.)

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Claims 52-55 have been amended to require that the controller automatically records image data either to a memory card or an internal memory based on whether there is a memory card inserted in the camera and it has sufficient room for an image. A warning is displayed after the controller automatically determines where the image information is to be recorded and then determines that there is insufficient capacity for an image. In contrast, the combination of Takahashi and Sasaki or Watanabe teaches that the destination for storing an image is manually selected by the operator. See Takahashi, column 4, lines 1-5 (“the store device selected by the operator, namely, the memory 40, the optical card 36, or the magnetic disk 58 is supplied so as to be fed to the controller”). A warning may be provided if the manually selected memory is full. Thus, it is respectfully submitted that claims 52-55 are not obvious over the cited references.

Each of claims 56-63 depend from one of claims 52-55. It is respectfully submitted, therefore, that each of claims 56-63 distinguish over the combination of Takahashi and Sasaki or Watanabe for at least the same reasons as their respective base claim.

Claims 64 distinguishes over Sasaki as provided above, at least because Sasaki fails to disclose, teach or suggest a digital camera including a controller adapted to “determine a remaining capacity of a memory card after the first image is stored to the memory card and prior to capturing a second image; and display a warning prior to capturing the second image if the remaining capacity of the memory card is insufficient to store the second image.” It is respectfully submitted that the other art of record, including Takahashi and Watanabe, also fails to teach this feature of claim 64. Accordingly, claim 64 distinguishes over any combination of Takahashi, Sasaki, and Watanabe and should be allowed.

Claims 65-67 depend from claim 52 and therefore distinguish any combination of Takahashi, Sasaki, and Watanabe for at least the same reasons as provided above regarding claim 52.

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Accordingly, it is respectfully requested that the rejection of claims 52-67 under 35 U.S.C. § 103(a) as being unpatentable over combinations of Takahashi, Sasaki, and Watanabe, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

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Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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